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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,785	04/09/1999	JAMES G. HANKO	843161-189	9037

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MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2628

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/289,785

Applicant(s)

HANKO, JAMES G.

Examiner

Jeffery A. Brier

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,14-22,24-30,34-41,43-48,50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 14-22, 24-30, 34-41, 43-48, 50, and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Response to Amendment

1. The amendments filed on 3/24/2006 have been entered.

Response to Argument

2. Applicants arguments filed on 3/24/2006 have been fully considered and in view of the amendments made to claims 1, 11, 21, and 34 they are deemed not to be persuasive. Each of claims 1, 21, and 34 claim "determining a nearest pixel in said image data to a corner location of said at least one clipping region" and claim 11 claims "determining a nearest pixel in said image data to a corner location of said at least one clipping region". These amended phrases claim due to the use of the word "a" a range of nearest pixels including only one. The amended phrases do not manifest "for each of two of the corner locations of said at least one rectangular clipping region determining one nearest pixel in said image data" in order to claim selecting P_{UL} and P_{LR} as disclosed at page 18 lines 14-25. *Lava Trading Inc. v. Sonic Trading Management LLC*, 78 USPQ2d 1624, 1629 (CA FC 2006).

Page 1629 states:

According to its preamble, claim 9 "provid[es] trading information to traders in a security or commodity" rather than "all" securities or commodities. '982 patent, col. 14, ll. 1-2 (emphasis added). By selecting the word "a" instead of "all," the Applicant set forth a method wherein the traders may request and receive information for only a subset of the securities (i.e., one or more). See *KCJ Corp. v. Kinetics Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (the word "a" generally means "one or more" in open-ended claims). Thus, the language of the claim itself does not require the system to distribute or display the whole combined order book.

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United States Court of Appeals for the Federal Circuit

05-1351,-1352

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION

and U.S. PHILIPS CORPORATION,

Plaintiffs-Cross Appellants,

v.

CONTEC CORPORATION, SEOBY ELECTRONICS CO., LTD.,

REMOTE SOLUTION, CO., LTD. (formerly known as Hango Electronics Co., Ltd.),

and HANGO REMOTE SOLUTION, INC.,

Defendants,

and

COMPO MICRO TECH, INC.,

Defendant-Appellant.

DECIDED: April 18, 2006

Page 10 states:

As for the phrases “an entry initiate key” and “entry initiate signal,” the district court acknowledged that an indefinite article normally means “one or more” in open-ended claims, but found sufficient evidence in the specification of the '562 patent and the prosecution history to limit “an” to the singular. We agree that “a” or “an” normally carries the meaning of “one or more” in claims containing the transitional phrase “comprising.” *KJC Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). Here, however, the patentee clearly intended the use of only one entry initiate key.

Thus, the newly amended “a corner” does not clearly claim two corners of the clipping region and “a nearest pixel” does not claim “one nearest pixel”. Thus, the claims do not clearly claim the invention.

In response to the arguments presented on pages 13 and 14 concerning claims 21 and 34 the examiner points out below that claims 1, 11, 21 and 34 broadly claim mapping as discussed above and they further do not claim the result of the mapping. The result of the mapping is not only transmitting the clipped image and scaling the received clipped image but also displaying the received scaled clipped image. Thus,

they lack essential steps of correlating the mapping steps and transmitting clipped image data over the network steps to a end result of the mapping e.g. a display step of displaying the scaled clipped image. Any amendment needs to be supported by the specification, see page 5 line 1 to page 6 line 6, page 7 lines 16-20, page 9 lines 17-25, page 13 lines 9-11, page 17 lines 1-5 and 20-22, and page 32 lines 1-9.

Claim form question

Page 34 lines 1-6 describes computer program product comprises a medium ... carrier waves. Claims 11, 14-20, and 38-40 claim "computer readable medium including program instructions". Do these claims claim a carrier wave as the computer readable medium which in view of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on the USPTO website on October 26, 2005,

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

and published in the OG 22Nov2005

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>) is now currently non-statutory? See ANNEX IV Computer-Related Nonstatutory Subject Matter of the Interim guidelines where a signal is held to be nonstatutory subject matter? Since applicants disclosed carrier wave is a signal then claims that claim a carrier wave as the medium for carrying the computer program product to the processor are nonstatutory. Since these amended claims do not have a direct description in the specification then applicant needs to clarify the scope of these claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 4-11, 14-22, 24-30, 34-41, 43-48, 50, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of claims 1, 21, and 34 claim "determining a nearest pixel in said image data to a corner location of said at least one clipping region" and claim 11 claims "determining a nearest pixel in said image data to a corner location of said at least one clipping region". These amended phrases claim due to the use of the word "a" a range of nearest pixels including only one. The amended phrases do not manifest "for each of two of the corner locations of said at least one rectangular clipping region determining one nearest pixel in said image data" in order to claim selecting P_{UL} and P_{LR} as disclosed at page 18 lines 14-25. Thus, the newly amended "a corner" does not clearly claim two corners of the clipping region and "a nearest pixel" does not claim "one nearest pixel". Claims 1, 11, 21 and 34 broadly claim mapping as discussed above and they further do not claim the result of the mapping. Claim 1 line 8 claims "for display", claim 11 line 12 claims "for display", claim 21 line 11 claims "for display", and claim 34 line 12 claims "for display". Thus, the claims do not clearly claim the invention since the claim is not clear if the received scaled transmitted clipped image data is displayed or just generating processed image data. Thus, they lack essential steps of correlating the mapping steps

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and transmitting clipped image data over the network steps e.g. a display step of displaying the scaled clipped image.

Allowable Subject Matter


5. Claims 1, 4-11, 14-22, 24-30, 34-41, 43-48, 50, and 51 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The prior art of record fails to teach or suggest that which is described with regards to figures 6A-7 and page 18 line 4 to page 20 line 21 in order to define the portion of the image to be transmitted from the server to the client.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffery A Brier
Primary Examiner
Division 2628